

REMARKS

This Response is submitted in reply to the Non-Final Office Action dated June 25, 2007. Claims 1, 8, 9, 11, 16, 20, 24, 26, 27, 30, 34, 37 and 43 have been amended. No new matter has been added by any of these amendments. Please charge deposit account number 02-1818 for any fees due in connection with this Response.

The Office Action rejected Claims 46 to 48 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action stated that step (e) of Claim 46 sets forth that every convertible symbol of said previous game play is a flanking symbol in a subsequent game play, however, as the prior steps of the same claim convert the convertible symbols into flanking symbols, there are no convertible symbols remaining after the conversion to define flanking symbols in a subsequent game play. Additionally, the Office Action stated that is unclear how the Applicant intends for this step to relate to the claimed invention presented in the remainder of the claim. Applicant respectfully disagrees with this rejection.

Nonetheless, the expedite prosecution of the present application, Applicant has amended independent Claim 46 to clarify that for each of at least one subsequent game play of the method of operating a gaming device of amended independent Claim 46, any convertible symbol of the previous game play which was not directly between two generated flanking symbols is adapted to function as the flanking symbol and one of the flanking symbols of the previous game play is adapted to function as the convertible symbol. Thus, if any convertible symbol of the previous game play of the method of operating a gaming device of amended independent Claim 46 was not directly between two generated flanking symbols, such a convertible symbol remains to be defined as a flanking symbol for at least one subsequent game play. Accordingly, Applicant submits that such rejections of Claim 46 (and Claims 47 to 48 which depend from Claim 46) have been overcome and as the Office Action did not otherwise reject Claims 46 to 48, such Claims are in condition for allowance.

The Office Action rejected Claims 1 to 27, 30 to 31, 34, 37 to 40, and 43 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,077,745 to Gomez et al. ("Gomez"). Applicant respectfully disagrees with this rejection.

Gomez discloses a method of conducting a wagering game on a gaming device (Col 1:46-47). In the wagering game, a player makes a wager and the gaming device generates an outcome and displays the outcome to the player (Col 2:18-26). The gaming device makes a determination of whether the generated outcome resulted in a winning combination of symbols on an active payline. A win completion feature can be used to generate a win for a non-winning combination of symbols (Col 3:41-43). In this win completion feature, a symbol is automatically replaced resulting in a winning outcome (Col 3:53-55). For example, a five reel slot game is disclosed in Gomez where five identical symbols along a payline signify a win (Col 3:43-50). If the game generates a series of symbols in an arrangement that nearly represents a win along an active payline (i.e. one of the five symbols on the active payline does not match the other four), the game completes the win by automatically inserting the final required symbol into the remaining position (Col 3:50-55).

Amended independent Claims 1, 11, 16 and 26 are each generally directed to a gaming device including, amongst other elements, a plurality of reels, a plurality of symbols on the reels, wherein at least two of the symbols are flanking symbols, at least one of the symbols is a convertible symbol, and at least one of the symbols is a non-convertible symbol, wherein if the non-convertible symbol is generated on the active payline associated with one of the reels which is directly between two flanking symbols generated on the active payline associated with two of the reels, the non-convertible symbol does not change to one of the flanking symbols.

Amended independent Claim 9 is generally directed to a gaming device including, amongst other elements, a plurality of reels, a plurality of symbols on the reels, wherein one or more of the symbols are flanking symbols, convertible symbols, flanking/convertible symbols or non-convertible symbols, wherein if a non-convertible symbol is generated on the active payline associated with one of the reels which is directly between two flanking symbols generated on the active payline associated with

two of the reels, the non-convertible symbol does not change to one of the flanking symbols.

Amended independent Claim 20 is generally directed to a gaming device including, amongst other elements, a plurality of reels, a plurality of symbols on the reels, wherein at least two of the symbols are flanking symbols, a plurality of the symbols are convertible symbols and at least one of the symbols is a non-convertible symbol, wherein if the non-convertible symbol is generated on the active payline associated with one of the reels which is directly between two flanking symbols generated on the active payline associated with two of the reels, the non-convertible symbol does not change to one of the flanking symbols.

The Office Action states that Gomez teaches a slot machine win completion feature including a plurality of symbols including flanking symbols and non-flanking symbols wherein the non-flanking symbols further comprise a plurality of similar or non-similar convertible symbols and non-convertible symbols. Applicant respectfully disagrees.

Applicant submits that in Gomez, if a plurality of symbols are generated and no winning combinations are present on any active paylines, a determination is made of whether or not replacing one of the displayed symbols will result in a winning combination. For example, in a five-reel slot game where five identical symbols along an active pay line signify a win, Gomez discloses automatically adding the fifth symbol when only four identical symbols are presented along the active pay line. Therefore, any symbol contained in Gomez can be changed dependent on the other generated symbols. On the other hand, Applicant submits that the gaming devices of amended independent Claims 1, 9, 11, 16, 20 and 26 each include non-convertible symbols, wherein if the non-convertible symbol is generated on an active payline associated with one of the reels which is directly between two flanking symbols generated on the active payline associated with two of the reels, the non-convertible symbol does not change to one of the flanking symbols. For example, in a five-reel slot game where five identical symbols along an active pay line signify a win and only four identical symbols are presented along the active pay line, in the gaming devices of amended independent

Claims 1, 9, 11, 16, 20 and 26, if the non-identical symbol on the active payline is a non-convertible symbol and the non-convertible symbol falls directly between two flanking symbols, the non-convertible symbol will not change to one of the flanking symbols. That is, a non-convertible symbol will not change, regardless of the other generated symbols. For at least these reasons, it is respectfully submitted that amended independent Claims 1, 9, 11, 16, 20 and 26 are patentably distinguished over Gomez and in condition for allowance.

Claims 2 to 7, 10, 12 to 15, 17 to 19, 21 to 23 and 25 depend directly or indirectly from amended independent Claims 1, 9, 11, 16, 20 and 26 and are also allowable for the reasons given with respect to amended independent Claims 1, 9, 11, 16, 20 and 26 and because of the additional features recited in these claims.

Independent Claim 8 is generally directed to a gaming device including, amongst other elements, a plurality of reels, a plurality of symbols on the reels, wherein the plurality of symbols include at least four symbols which are each adapted to function as a flanking symbol or as a convertible symbol, wherein upon a first play of the primary game, two of the symbols function as flanking symbols and one of the symbols functions as the convertible symbol and upon a second play of the primary game, the convertible symbol of the first play of the primary game functions as the flanking symbol and one of the flanking symbols of the first play of the primary game functions as the convertible symbol. The gaming device of independent Claim 8 also includes a processor operable for each play of the primary game to cause the generation of at least one of the symbols on each of the reels, change each convertible symbol to one of the flanking symbols if the convertible symbol is generated on an active payline associated with one of the reels which is directly between two flanking symbols generated on an active payline associated with two of the reels, display any of the changes to the player and provide the player an award based on any winning combination of symbols on the reels.

The Office Action states that Gomez teaches a slot machine win completion feature including a processor to cause the generation of symbols on each of said reels and when a non-flanking convertible symbol appears on the same active payline as a

flanking symbol converting the convertible symbol into a flanking symbol in a manner appreciable to the player. Applicant respectfully disagrees.

Applicant submits that in Gomez, each subsequent game play occurs independently from the previous game. That is, the function of a symbol in a subsequent game is independent from the function of the symbol in a previous game(s). On the other hand, Applicant submits that the gaming device of amended independent Claim 8 includes a plurality of symbols on the reels, wherein the convertible symbol from a first play of a primary game functions as the flanking symbol during a second play of the primary game and one of the flanking symbols from the first play of the primary game functions as the convertible symbol during the second play of the primary game. For example, if a symbol functions as a convertible symbol in a primary game, that same symbol will function as a flanking symbol in the next subsequent game. That is, for the gaming device of amended independent Claim 8, the function of certain symbols in a subsequent game play depend from the function of those symbols in a previous game play. For this reason alone, it is respectfully submitted that independent Claim 8 is patentably distinguished over Gomez and in condition for allowance.

Amended independent Claim 30 is generally directed to a method of operating a gaming device including, amongst other elements, generating a plurality of symbols on an active payline associated with a plurality of reels, wherein one or more of the symbols are flanking symbols, convertible symbols or flanking/convertible symbols, enabling a player to designate at least one of the flanking/convertible symbols as a flanking symbol and enabling the player to designate at least one of the flanking/convertible symbols as a convertible symbol. Applicant submits that Gomez does not disclose player designation for any symbol. That is, the determination to change any symbols in Gomez is based on the other symbols generated and not based on any player designation. For this reason alone, it is respectfully submitted that amended independent Claim 30 is patentably distinguished over Gomez and in condition for allowance.

Claims 32 and 33 depend directly or indirectly from amended independent Claim 30 and are also allowable for the reasons given with respect to amended independent Claim 30 and because of the additional features recited in these claims.

Amended independent Claim 27 is generally directed to a method of operating a gaming device including, amongst other elements, generating a plurality of symbols on a payline associated with a plurality of reels, wherein at least one of the generated symbols is a predetermined convertible symbol and a plurality of the symbols are predetermined flanking symbols.

Amended independent Claim 34 is generally directed to a method of operating a gaming device including, amongst other elements, generating a predetermined flanking symbol on an active payline associated with a first reel, a predetermined convertible symbol on the active payline associated with a second reel and a predetermined flanking symbol on the active payline associated with a third reel.

Amended independent Claim 43 is generally directed to a method of operating a gaming device including, amongst other elements, generating a plurality of symbols on an active payline associated with a plurality of reels, wherein at least one of the generated symbols is a predetermined convertible symbol and a plurality of the symbols are predetermined flanking symbols.

Applicant submits that in Gomez, any generated symbol can change or can cause another symbol to change. That is, the function of a generated symbol in Gomez depends on the other generated symbol(s) in a game (i.e. in the five reel example above, whether or not the fifth symbol is automatically inserted depends on the other four generated identical symbols). On the other hand, Applicant submits that amended independent Claims 27, 34 and 43 are each generally directed toward a method of operating a gaming device including, amongst other elements, generating predetermined flanking symbols and predetermined convertible symbols. That is, only certain symbols are predetermined to function as flanking symbols (i.e. which can cause another symbol to change) and only certain symbols are predetermined to function as convertible symbols (i.e., which can be changed). Applicant submits that Gomez does not disclose generating any symbols that are predetermined to function as flanking

symbols or any symbols that are predetermined to function as convertible symbols. For this reason alone, it is respectfully submitted that amended independent Claims 27, 34 and 43 are patentably distinguished over Gomez and in condition for allowance.

Claims 28 to 29, 35 to 36 and 44 to 45 depend directly or indirectly from amended independent Claims 27, 34 and 43 and are also allowable for the reasons given with respect to amended independent Claims 27, 34 and 43 and because of the additional features recited in these claims.

Regarding amended independent Claims 24 and 37 the Office Action states that Gomez sets forth spinning the reels, and as best understood the Applicant's presented Claim 24 sets forth steps (a) through (j) as the assignment and re-assignment of symbols to reel positions followed by a singular display step (k). Accordingly the presented claim is understood to describe the process of spinning the reels as set forth by Gomez. Applicant respectfully disagrees.

Amended independent Claims 24 and 37 are each generally directed to a gaming device/method which generally include generating one of the flanking symbols on an active payline associated with a first of the reels, generating one of the flanking/convertible symbols on the active payline associated with a second of the reels, generating one of the flanking/convertible symbols on the active payline associated with a third of the reels, generating one of the flanking/convertible symbols on the active payline associated with a fourth of the reels, generating one of the flanking symbols on the active payline associated with a fifth of the reels, designating the flanking/convertible symbols on the second and fourth reel as flanking symbols, designating the flanking/convertible symbol on the third reel as a convertible symbol, changing the designated convertible symbol on the third reel to one of the flanking symbols, displaying any said change to the player, providing the player any award based on any winning combination of the displayed symbols on the active payline associated with the reels, designating the flanking/convertible symbols on the second, third and fourth reels as convertible symbols, changing the designated convertible symbols on the second, third and fourth reels to one of the flanking symbols, displaying any change to the

player, and providing the player any award based on any winning combination of the displayed symbols on the active payline associated with the reels.

As disclosed above, the gaming device of Gomez limits symbol conversion and symbol display to a single occurrence, after which the player is provided with an award based on the displayed symbol combinations and play of the primary game ends. That is, Gomez does not disclose a process wherein a symbol is changed at least two times in a primary game. Unlike Gomez, amended independent Claims 24 and 37 each generally disclose a multiple step process that generates, designates, converts and displays symbols and awards to the player, wherein the symbol conversion and display steps as well as the player award step occur multiple times throughout play in a primary game. Additionally, unlike Gomez, amended independent Claims 24 and 37 each disclose a symbol on a reel associated with an active payline that is converted at least two times during the play of a primary game (i.e. the flanking/convertible symbol on the third reel is converted to one of the flanking symbols from the second and fourth reels and then the symbol on the third reel, along with the symbols on the second and fourth reels, is converted to one of the flanking symbols from the first and fifth reels). For at least these reasons, it is respectfully submitted that amended independent Claims 24 and 37 are patentably distinguished over Gomez and in condition for allowance.

Claims 25 and 38 to 42 depend directly or indirectly from amended independent Claims 24 and 37 and are also allowable for the reasons given with respect to amended independent Claims 24 and 37 and because of the additional features recited in these claims.

The Office Action rejected Claims 28 to 29, 32 to 33, 35 to 36, 41 to 42 and 44 to 45 under 35 U.S.C. §103(a) as being unpatentable over issued U.S. Patent No. 7,077,745 to Gomez et al. ("Gomez"), and further in view of U.S. published Patent Application No. 2003/0100356 to Brown et al. ("Brown"). Applicant respectfully disagrees with this rejection.

The Office Action states that the Gomez is silent regarding the inclusion of an internet network, however in a related symbol conversion game, Brown teaches the utilization of the internet network. The Office Action states that it would have been

obvious to one of ordinary skill in the art, at the time of the invention to have incorporated the use of the internet as taught by Brown into the invention of Gomez to allow the utilization of the wagering platform for online casinos as taught by Brown.

Applicant submits that regardless of whether or not it would have been obvious to have incorporated the use of the internet in Gomez, neither Gomez nor Brown individually, nor the gaming device resulting from the combination of Gomez and Brown discloses the gaming device and methods described in Claims 1 to 48.

More specifically, unlike Claims 41 and 42 as described above with respect to amended independent Claim 37, neither Gomez or Brown nor the combination of Gomez and Brown disclose a method of operating a gaming device, wherein a symbol on a reel associated with an active payline is converted at least two times during the play of a primary game.


Additionally, unlike Claims 28, 29, 35, 36, 44 and 45 as described above with respect to amended independent Claims 27, 34 and 43 neither Gomez or Brown nor the combination of Gomez and Brown disclose a method of operating a gaming device including, amongst other elements, generating a plurality of the symbols on a payline associated with a plurality of reels, wherein at least one of the generated symbols is a predetermined symbol. That is, neither Gomez or Brown nor the combination of Gomez and Brown disclose generating symbols, wherein only certain symbols are predetermined to function as flanking symbols and only certain symbols are predetermined to function as convertible symbols.

Furthermore, unlike Claims 32 and 33 as described above with respect to amended independent Claim 30, neither Gomez or Brown nor the combination of Gomez and Brown disclose enabling a player to designate at least one of the flanking/convertible symbols as a flanking symbol and enabling the player to designate at least one of the flanking/convertible symbols as a convertible symbol.

For at least these reasons, Applicant respectfully submits that Claims 28, 29, 32, 33, 35, 36, 41, 42, 44 and 45 are patentably distinguished over Gomez and Brown and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

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